



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,594	11/29/2001	Takashi Yamada	216692US2	2712

22850 7590 01/29/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.

1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

DICKEY, THOMAS L

ART UNIT

PAPER NUMBER

2826

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/995,594

Applicant(s)

YAMADA ET AL.

Examin r

Thomas L Dickey

Art Unit

2826

NLW

--Th MAILING DATE of this communication app ars on th cover sh t with th correspond nc address --

THE REPLY FILED 12/2/03 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): _____.
4. ☒ Newly proposed or amended claim(s) 1-4, 6-13, 15, 29 and 30 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 7, 8 and 14.

Claim(s) objected to: 30 and 31.

Claim(s) rejected: 1-6, 9-13, 15 and 29.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper filed 12/03/03.
10. ☐ Other: _____

Minhloan Tran
Minhloan Tran
Primary Examiner
Art Unit 2826

Continuation of 2. NOTE: Applicant proposes to cancel claim 31, previously indicated allowable, and amend independent claim 1 to include all limitations of claim 31. This amendment presently would appear to render claims 1-4,6,10-13, 15, and 29 allowable, since applicant proposes that claims 2-4,6,10-13, 15, and 29 should ultimately depend from claim 1.

Claim 7 was previously indicated allowable. In spite of this applicant proposes to amend claim 7. However, it appears at present that applicant's amendment does not change the scope of claim 7. Applicant further proposes to replace independent claim 9 with a claim that depends from claim 7. These proposed changes would appear to render all of claims 7-9 allowable.

Claim 14 was previously indicated allowable. Applicant does not propose to amend claim 14, thus claim 14 appears to remain allowable. Applicant withdrew claims 16-28 from consideration on 1/23/03. Claims 16-28 remain in the application but cannot be considered along with the invention currently under examination.

Applicant proposes to amend claim 30 but only to cast claim 30 in independent form. Claim 30 was previously indicated allowable if rewritten in independent form.

As applicant states on page 12 of the remarks, independent claim 5 in its current form was rejected as anticipated by Davari et al. 6,333,532. Applicant proposes to avoid the prior art by amending claim 5 to include all its previous limitations and in addition the elements "a first isolation formed in the bulk device so as to separate the bulk device, and a second isolation formed in the SOI device region so as to separate the SOI device, the first and second isolations being substantially the same depth and having a depth reaching the buried insulator." Proposed claim 5 presents a combination never before searched or considered (applicant must keep in mind that although the various elements are present in other claims, the combination defines the scope of claim 5, and the proposed combination claim has not before been presented). Entry of proposed claim 5 at this time would therefore raise a new issue that would require further consideration and search..